

REMARKS

This responds to the Office Action dated May 7, 2007.

Claims 1, 4-10, 13 and 17 are amended, claims 11, 29 and 36 are canceled, and no claims are added; as a result, claims 1-10, 12-28, and 30-35 are now pending in this application.

§102 Rejection of the Claims

Claims 1-10, 12-28 and 31-35 were rejected under 35 U.S.C. § 102(e) for anticipation by Grainger et al. (U.S. Patent Application Publication No. 2002/0065677 A1, hereinafter "Grainger"). Applicant respectfully traverses the rejection of these claims under 35 U.S.C. § 102(e) for the reasons stated as follows.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Regarding independent claim 1:

Applicant has amended claim 1. Amended claim 1 recites as follows:

1. A system for managing information disclosure statement (IDS) references, comprising:
 a computing system;
 a first software component operable on the computing system to generate a plurality of IDS forms;
 a second software component operable on the computing system to manage IDS references for at least one organization; and
 a task managing software component operable on the computing system to manage tasks within matters; and
 a database comprising the IDS references,
 wherein **each organization only has access to its own IDS references.**
(emphasis added)

The Office Action restates that Grainger teaches the feature of claim 1, “each organization only has access to its own IDS references.” Applicant disagrees.

Applicant submits that Grainger actually teach away from the feature **“each organization only has access to its own IDS references”** as positively recited in claim 1. Referring to Figure 6 of the present application, a system is shown with three organizations A, B and C, where each organization A, B or C only has access to its own IDS references, thus the organizations A, B and C do not share IDS references.

However, in Grainger, two organizations may share the IDS references. Referring to para [0038], lines 16-21, Grainger states:

“an electronic IDS may also be a electronic file storing a plurality of pointers. Each pointer may correspond to a relevant local or remote electronic document containing IDS information that must be submitted to an official patent office.” (emphasis added)

It can be clearly seen that, in Grainger, the electronic IDS may store pointers pointing to IDS references referenced by one organization, and the IDS references may also be referenced by another organization by using pointers, then the two organizations may share the same IDS references because of the usage of pointers, which means that one organization may has access to IDS references that are not owned by this organization. Accordingly, the above citation from Grainger actually teach away from the feature “each organization only has access to its own IDS references” as positively recited in claim 1. Accordingly, Grainger does not disclose the feature “each organization only has access to its own IDS references” as positively recited in claim 1.

The Office Action, citing para [0038] and para [0081] of Grainger, asserts “Grainger teaches a system with an electronic IDS/electronic document storage component (Para 0038)” and “Grainger also discloses controlling user access rights to the IDS information (Para 0081, organizations maintain control of who access their IDS records through access codes).” The above assertions of the Office Action cannot lead to the conclusion that Grainger discloses the feature “each organization only has access to its own IDS references” as positively recited in claim 1, because Grainger teaches away from this feature of claim 1. As discussed above, **two organizations of Grainger may share the same IDS references by the usage of pointers, one organization of Grainger may has access to IDS references not owned by itself.**

Grainger also fails to disclose a feature **“a database comprising the IDS references”** as recited in amended claim 1.

Furthermore, Grainger also fails to disclose a feature **“a task managing software component** operable on the computing system to manage **tasks within matters”** as recited in amended claim 1. Actually, Grainger does not mention **“tasks within the matters”** at all.

Therefore, Grainger does not disclose each and every element of independent claim 1, accordingly does not anticipate independent claim 1. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(e).

Regarding independent claims 10, 17 and 21:

Independent claims 10, 17 and 21 each include a feature similar to the feature **“each organization only has access to its own IDS references”** as positively recited in claim 1. Thus, for the same reasons discussed above for claim 1, Applicant submits that Grainger does not disclose such similar feature **“each organization only has access to its own IDS references”** as recited in claims 10, 17 and 21, accordingly does not anticipate these independent claims. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10, 17 and 21 under 35 U.S.C. § 102(e).

Regarding independent claim 13:

Independent claim 13 includes features **“the method manages the first matter and tasks within the first matter”** and **“the new IDS reference is only accessible to the organization who owns the first matter and the selected matters”**. For the similar reasons discussed for claim 1, Grainger does not disclose these two features as recited in independent claim 13. Therefore, Grainger does not disclose each and every element of independent claim 13, accordingly does not anticipate independent claim 13. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 13 under 35 U.S.C. § 102(e).

Regarding dependent claims 2-9, 12, 14-16, 18-20, 22-28 and 31-35:

Dependent claims 2-9, 12, 14-16, 18-20, 22-28 and 31-35 respectively, directly or indirectly, depend on independent claims 1, 10, 13, 17 and 21. Thus, for at least the same

reasons discussed for independent claims 1, 10, 13, 17 and 21, Applicant respectfully submits that Grainger does not anticipate these dependent claims. Applicant respectfully requests reconsideration and withdrawal of the rejection of these dependent claims under 35 U.S.C. § 102(e).

§103 Rejection of the Claims

Claim 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Grainger in view of Official Notice.

Applicant respectfully traverses the rejection of claim 30 under 35 U.S.C. § 103(a) for the reasons stated below.

The Office Action acknowledges that Grainger fails to teach “providing an accounting system to track costs associated with storing IDS references” which is recited in claim 30.

Claim 30 depends on claim 21, accordingly includes the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” of claim 21. However, as discussed above, Grainger actually teach away from the feature “restricting access to IDS references so that each organization only has access to its own IDS references” as included in claim 30. Because para 0038 of Grainger shows that **the electronic IDS** referenced by one organization **may contain pointers** pointing to IDS references and the IDS references may also be referenced by another organization, in contrast to claim 30, the two organizations of Grainger may share the same IDS references by the use of pointers. Thus, Applicant submits that Grainger does not disclose such feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” as included in claim 30.

Also see paragraph 0080 of the Grainger publication, which states the following: “Additionally, each client system would be able to access all of the electronic IDS stored in database 804. This embodiment is particularly suited for applications where multiple users will be generating and accessing the same electronic IDS for a single pending or future patent application.” And see paragraph 0081, “the access to each electric IDS may be limited to individuals falling under the duty of disclosure for the corresponding future or pending patent application.” Thus, according to Grainger, it can be seen that individuals may have access to IDS references which are not their own, as long as they are falling under the duty of disclosure

for the corresponding future or pending patent application. Therefore, clearly, Grainger teaches away from the feature “**each organization only has access to its own IDS references**” which is included in claim 30.

Thus, Grainger does not teach or suggest all the limitations which are recited in claim 30, and certainly does not suggest to combine reference teachings. Accordingly, Applicant submits that claim 30 is not rendered obvious over Grainger in view of Official Notice, and respectfully request that the rejection of claim 30 under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

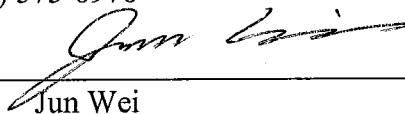
Respectfully submitted,

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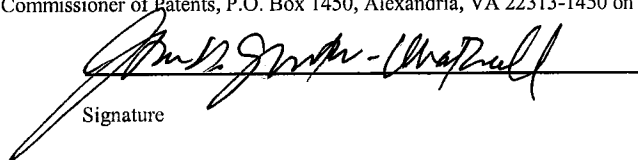
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Name


Signature